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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,686	10/22/2003	Rama K.T. Akkiraju	GB920030072US1	6118
48915 7590 01/09/2009 CANTOR COLBURN LLP-IBM YORKTOWN 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
01/09/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary

Application No.

10/690,686

Applicant(s)

AKKIRAJU ET AL.

Examiner

JOHN M. WINTER

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicant's amendment filed on October 10, 2008 is acknowledged, Claims 1-2, 4, 5, remain pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2008 has been entered.

Response to Arguments

3. The Applicants arguments filed on October 10, 2007 have been fully considered.

The Applicant states that the combination of the teachings of the cited references of record fail to disclose each and every element of the claims, the Applicants respectfully submit that the § 103 rejections have been addressed and overcome.

The Examiner states that the language that Applicant considers lacking from the prior art reference "selecting from a plurality of external matching services an external matching service which, itself, comprises an external, published search engine independent of a search engine internal to the UDDI registry, the published search engine capable of comparing the service requirements and service capabilities through semantic cues in the UDDI request, wherein each external matching service is accessed through an interface defined in an interface tModel;" is largely directed towards a description of the external

search engine, the Examiner submits that this particular language does not serve as a limitation on the claim. In other words **language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation**. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims. The Examiner submits that the feature of “selecting from a plurality of external matching services an external matching service” is disclosed by the prior art reference Flete her et al (Column 7, lines 15-54).

Claim Rejections - 35 USC § 101

Claims 1-2, 4,5 and 29 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 1 fails prong (1) because the “tie” (e.g. UDDI registry, and an external matching service) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 2, 4, 5 and 29 are dependant upon claim 1 and are rejected for at least he same reason.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nykänen (US Patent 7,155,425) in view of Fletcher et al. (US Patent 6,985,939) and further in view of Zeng et al (US Patent Application Publication 2004/0220910).

6. As per claim 1

Nykänen ('425) discloses a data processing method for a UDDI registry to enable location of details of services which match service requester requirements, the method of the UDDI registry comprising the steps:

receiving a standard UDDI request to locate service details, the request comprising details of a tModel which defines service requirements specified in a particular language;(Column 7, line 45—column 8 line 42)

locating details of at least one service, the details comprising a tModel which defines service capabilities specified in the particular language;(Column 7, line 45—column 8 line 42)

Nykänen ('425) does not explicitly disclose selecting from a plurality of external matching services an external matching service which is capable of comparing the service requirements and service capabilities, wherein each external matching service is accessed through an interface defined in an interface tModel; and using the external matching service to filter the located details to find those with indicated service capabilities which match the service requirements.. Fletcher et al. ('939) discloses selecting from a plurality of external matching services an external matching service which is capable of comparing the service requirements and service capabilities, wherein each external matching service is accessed through an interface defined in an interface tModel; and using the external matching service to filter the located details to find those with indicated service capabilities which match the service requirements. (Column 7, lines 15-54) It would be obvious to one having ordinary

skill in the art at the time the invention was made to combine the Nykänen ('425) method with the Fletcher et al. ('939) method in order to optimize the content of a web portal; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Nykänen ('425) does not explicitly disclose receiving a request to register a new external matching engine wherein the matching engine implements the interface defined in the interface tModel; wherein the plurality of external matching services includes the new matching engine.. Fletcher et al. ('939) discloses receiving a request to register a new external matching engine wherein the matching engine implements the interface defined in the interface tModel; wherein the plurality of external matching services includes the new matching engine.

. (Column 10, lines 39-60) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Nykänen ('425) method with the Fletcher et al. ('939) method in order to optimize the content of a web portal; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Nykänen ('425) does not explicitly disclose comprises an external, published search engine independent of a search engine internal to the UDDI registry, the published search engine is capable of comparing the service requirements and service capabilities through semantic cues in the UDDI request. Zang et al. ('910) discloses comprises an external, published

search engine independent of a search engine internal to the UDDI registry, the published search engine is capable of comparing the service requirements and service capabilities through semantic cues in the UDDI request. (Paragraph 26) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Nykänen ('425) method with the Zang et al. ('910) method in order to optimize the content of a web portal; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

7. Claim 29 is not patentably distinct from claim 1 and is rejected for at least the same reasons.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted. In regard to claim 1 and 29 the claimed feature of "capable of" imposes no limit upon the scope of the claim.

8. As per claim 2

Nykänen ('425)) discloses the method of claim 1 wherein the standard UDDI request further comprises service requirements specified in a standard UDDI category, the method comprising the further step of:

finding details of at least one service, the details defining service capabilities which

match the service requirements specified in a standard UDDI category; wherein the locating step locates details of at least one service from those found by the finding step.(Column 7, line 45—column 8 line 42)

9. As per claim 4

Nykänen ('425)) discloses the method of claim 1 wherein the standard UDDI request is a find_tModel request (Figure 4B)

10. As per claim 5

Nykänen ('425)) discloses the method of claim 1

Official Notice is taken that “the particular language is one of DAML-S, UML, and WSDL.” is common and well known in prior art in reference to object modeling. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize an object modeling protocol in order to model objects

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685